

REMARKS

Claims 1-54 were presented with the application as filed on January 3, 2006. In a concurrently-filed preliminary amendment, Applicants canceled claims 1-54 and added new claims 55 and 56. In their Second Preliminary Amendment, filed August 7, 2006, Applicants canceled claims 55 and 56 and added new claims 57-98. In their September 15, 2009 Response to a Restriction Requirement, Applicants elected without traverse Group V (claims 72-85 and 96, drawn to products of formula IV, formula V, formula VI, formula VII, and formula VIIa). In their March 25, 2010 Response to the first Office Action, Applicants amended claims 74, 77, and 78, and added new claim 99. In their September 16, 2010 Response to a second Office Action, Applicants amended claims 82, 83, and 96, added new claims 100-135, and canceled claims 57-81, 84-85, 87-95, and 99.

Currently, Applicants cancel method claims 86, 97-98, and 120-135, amend claim 110 to clarify and provide antecedent basis for the recited limitation, and amend claims 82, 105, 106, and 112-114, as described below. Claims 82-83, 96, and 100-119 are pending.

The Examiner's rejections are addressed below, following Applicants' Examiner Interview Summary. Reconsideration of the application and allowance of all claims pending herein are respectfully requested in view of the following remarks.

I. EXAMINER INTERVIEW SUMMARY

Applicants thank Examiner Stockton for the telephone interview graciously granted on February 3, 2011, between Examiner Stockton and Applicants' representative, Erica Hines. The MPEP suggests that, to be complete, an interview summary must address the following issues. Applicants' summary follows each category.

(A) A brief description of the nature of any exhibit shown or any demonstration conducted – Not applicable

(B) Identification of the claims discussed – Not applicable.

(C) Identification of specific prior art discussed – WO 02/059111 by Bebbington et al. (published August 1, 2008).

(D) Identification of the principal proposed amendments of a substantive nature discussed, unless there are already described on the Interview Summary form completed by the examiner – Not applicable.

(E) The general thrust of the principal arguments of the applicant and the examiner should also be identified – Not applicable.

(F) A general indication of any other pertinent matters discussed – Applicants requested that the Examiner consider WO 2002/059111 (Bebbington et al.), which is submitted herewith. On their July 16, 2009 IDS, Applicants cited US 2004/0214814 by Bebbington et al. While the references share a similar disclosure, they have different claims and inventorship, and, out of an abundance of caution, Applicants requested that WO 02/059111 also be considered.

(G) If appropriate, the general results or outcome of the interview – The Examiner indicated that she would consider WO 02/059111 if Applicants' Response placed the application in condition for allowance. The unexamined method claims have been canceled, and, for the reasons discussed herein, the remaining claims are believed to be allowable.

II. CLAIM REJECTIONS – NONSTATUTORY DOUBLE PATENTING

The Office Action indicates that claims 82, 83, 96, and 100-119 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 132-138, 140-143, 145-147, 162 and 163; and over claims 214-224 of co-pending Application No. 12/306,479. Applicants will address the double patenting issue when and if doing so is necessary during prosecution of Application No. 12/306,479, which is currently awaiting examination.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 112

The Office Action rejects claims 82, 83, 96, and 100-119 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Each of the specific rejections is addressed below.

Claim 82 is rejected as indefinite because the last seven lines of the claim allow “R¹⁰” to be substituted with a further substituent group which is also defined as “R¹⁰”. Applicants have amended claim 82 to refer to the further substituent groups as “R¹⁰” as opposed to “R¹⁰”. Claim 82 no longer refers to “R¹⁰” as being substituted by a group that is named “R¹⁰”.

Claim 105 is rejected because there is no “and” on line 3 of the claim between the penultimate and ultimate members of the Markush group. Applicants have amended claim 105 using proper Markush language by adding the requisite “and” after “carboxy”.

Claim 105 is also rejected because there is no “and” on line 6 of the claim between the penultimate and ultimate members of the Markush group. Applicants have amended claim 105 using proper Markush language by adding the requisite “and” before “carboxy”.

Claim 106 is rejected because there is no “and” on line 2 of the claim between the penultimate and ultimate members of the Markush group. Applicants have amended claim 106 using proper Markush language by adding the requisite “and” after “trifluoromethyl”.

Claim 112 is rejected because there is no “and” on the eleventh line from the end of the claim, between the penultimate and ultimate members of the Markush group. Applicants have amended claim 112 using proper Markush language by adding the requisite “and” before “alkoxycarbonylamino”.

Claim 113 is rejected because on line 9, the claim recites an “and” which should be an “or”. Applicants have amended claim 113 by replacing the “and” with an “or”.

Claim 114 is rejected because the substituent defined by the “(1)” definition (i.e., the “quioxalinyl”) is unclear. Applicants have amended claim 114 by correcting the typographical

error, such that the claim now recites “quinoxalinyl”. Support for the quinoxalinyl substituent can be found in Applicants’ specification, for example, on page 34 at line 22.

Claim 114 is also rejected because “under the definition of R^{1c}, the use of “selected from” is improper since R^{1c} can only represent an unsubstituted phenyl.” Claim 114 encompasses compounds according to claim 82 “wherein R^{1d} is a group R^{1c*}. Possible radicals at R^{1c} are listed in subparts (a) through (ac), and when A is NH(C=O), R^{1c} may also be unsubstituted phenyl (see subpart (ad)). Since R^{1c} may be any of groups (a) through (ac) or (ad), Applicants respectfully submit that claim language indicating that R^{1c} is “selected from” the listed substituents does not render the claim indefinite, and a skilled artisan would understand what Applicants intend to claim (see MPEP § 2173.02).

V. CONCLUSION

In view of the foregoing, reconsideration and withdrawal of the rejections are respectfully requested.

No fees are believed due. However, the Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 08-1935, Reference No. 3073.004A.

The previously-withdrawn method claims have been deleted, and the remaining subject matter has been searched and examined. There being no other outstanding issues, it is believed that the application is in condition for allowance, and such action is respectfully requested. Should the Examiner find that the application is in condition for allowance, Applicants would be most grateful if the Examiner would consider WO 02/059111.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone her at the number provided.

Respectfully submitted,



Erica M. Hines, Esq.
Attorney for Applicants
Registration No. 65,765

Dated: February 18, 2011

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203
Telephone: (518) 452-5600
Facsimile: (518) 452-5579